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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,062	01/31/2002	James G. Bledsoe	25174A	2671

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EXAMINER

STAICOVICI, STEFAN

ART UNIT PAPER NUMBER

1732

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/062,062	<b>Applicant(s)</b> BLEDSOE ET AL.	
	<b>Examiner</b> Stefan Staicovici	<b>Art Unit</b> 1732	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): None.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 9,10 and 42.

Claim(s) objected to: None.

Claim(s) rejected: 1-8,11,12,34-41,43 and 44.

Claim(s) withdrawn from consideration: None.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_

13. ☒ Other: See attachment.

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***ATTACHMENT TO ADVISORY ACTION***

***Response to After-Final Amendment***

1. Applicant's After-Final amendment filed May 13, 2005 has not been entered because the proposed amendments raise new issues that would require further consideration and a new search. Specifically, the newly added transitory phrase in claims 1 and 34 of "consisting essentially" limits the scope of a claim to the specified materials or steps hence, introducing subject matter that would require further consideration and a new search.

Claims 1-12 and 34-44 are pending in the instant application.

***Response to Arguments***

2. Applicants' arguments in the After-Final amendment filed May 13, 2005 have been fully considered but they are not persuasive.

Applicants argue that because "Figure 2 does not show any means for heating...it is understood by those skilled in the art that there is no heat applied" (see page 8 of the After-Final amendment filed 5/13/2005). Further, Applicants argue that because the original disclosure describes a "quick acting material," such as a "polyester/epoxy blend" that "flows into holes, " that "those skilled in the art" recognize that such a material is "flowable at room temperature" and "there is no heat applied" (see page 8 of the After-Final amendment filed 5/13/2005).

In response, it is noted that MPEP §2163.02 specifically states that the "fundamental factual inquiry is whether the specification conveys with *reasonable clarity* (emphasis added) to those skilled in the art that, as of the filing date sought, applicant was in possession of the

invention as now claimed. *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Furthermore, MPEP §2163.02 provides that an “[A]pplicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such *descriptive means* (emphasis added) as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Therefore, in order to show possession of the claimed invention, Applicants are required to use descriptive means as defined by the list provided in MPEP §2163.02. In the instant application, Applicants have not provided any descriptive means, as defined by MPEP §2163.02, to show forcing the resin into the perforations “without the use of heat.”

It is submitted that a simple negative recitation of a limitation does not meet the “descriptive means” test of MPEP §2163.02 because, it does not convey with *reasonable clarity* (emphasis added) that the “applicant was in possession of the invention as now claimed.” Further, it is submitted that although “literal support” is not required, a form of *descriptive means* (emphasis added) is required to set forth the negative limitation, which would have conveyed to one of ordinary skill in the art that Applicants had possession of the negative limitation.

Applicants’ position that the description of a “quick acting material,” such as a “polyester/epoxy blend” that “flows into holes” would reasonably convey to one ordinarily skilled in the art that such a material is “flowable at room temperature” and “there is no heat applied” (see page 8 of the After-Final amendment filed 5/13/2005) is not persuasive for at least

two reasons. First, under MPEP § 2111.03, the use of transitional term “comprising”, is synonymous with “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps, such as using heat. *See*, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997). Secondly, although under § 2111.01, Applicant may be his or her own lexicographer, any special meaning assigned to “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention. *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). In the instant situation, it is noted that a “quick-setting material” is not limited to a material that is curable at room temperature as Applicants imply, but a material that is cured in a short time. As such, it is submitted that a polyester/epoxy blend is heat curable when a shorter curing time is required. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants further argue, “those skilled in the art recognize that when a ‘hot pressing’ step is described as one embodiment, then the other steps are carried out at ambient temperature” (see page 9 of the After-Final amendment filed 5/13/2005). This argument is not found persuasive because the embodiment to which Applicants refer specifically teach using heat and pressure to compress a fiber reinforced plastic sheet against a perforated panel, hence teaching that resin flow occurs under conditions of heat and pressure (see page 6, lines 11-17).

Applicants argue that “the specification fully and adequately mentions heat when necessary to distinguish from ambient temperature, ” specifically describing “the effects of detrimental heat on the composite sheet” as exemplified at “page 9, line 27 through page 10, line 13” (see page 9 of the After-Final amendment filed 5/13/2005). In response, it is noted that Applicants’ argument is drawn to the detrimental effect of heat during usage of the *molded* (emphasis added) composite sheet due to the existence of air bubbles that were not removed during the manufacturing process. As such, Applicants’ argument is not related to the claimed limitation of “forcing resin into the perforations...without the use of heat,” which occurs *during* (emphasis added) the manufacturing process. Therefore, by not excluding the “use of heat” either literally or constructively, the original disclosure would not have reasonably conveyed to one having ordinary skill in the art that Applicants were in possession of the invention as now claimed.

Hence, the rejection of claims 1-8, 11-12, 34-41 and 43-44 under 35 USC 112, 1<sup>st</sup> paragraph is maintained. Claims 9-10 and 42 have been allowed.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (571) 272-1208. The examiner can normally be reached on Monday-Friday 9:30 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni, can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stefan Staicovici, PhD

  
Primary Examiner 5/25/05

AU 1732

May 25, 2005